

### **REMARKS**

This application has been reviewed in light of the Office Action dated February 9, 2009. Claims 1-19 are pending in the application. By the present amendment, claims 1 and 10 have been amended. No new matter has been added. The Examiner's reconsideration of the rejection in view of the amendments and the following remarks is respectfully requested.

#### **Rejections under 35 U.S.C. 101**

By the Office Action, claims 1-19 are rejected under 35 U.S.C. 101 as not being directed to statutory subject matter. The Examiner asserts that the system recited claims 1-9 can be implemented in all software. The Examiner further contends that method recited in claims 10-19 "neither transform underlying subject matter nor positively tie another statutory category that accomplishes the claimed steps." The applicants respectfully disagree.

Independent claim 1 positively recites "a network mobile device," "a transceiver," and "memory." Likewise, independent claim 10 recites "a network mobile device," "providing a device," and "configuring the device." The applicants assert that these elements sufficiently tie the claims to another statutory category.

The Examiner states that the above elements "can be referred merely to various forms of software" in light of page 2, lines 18-25 of the present specification. The applicants disagree with this interpretation of the claim language. MPEP §2111.01 states in pertinent part:

[T]he words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. ... "Plain meaning" refers to the *ordinary and customary meaning given to the term by those of ordinary skill in the art*. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of

ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*). (emphasis added)

To one skilled in the art, the ordinary and customary meaning of "a network mobile device," "a transceiver" and "memory" associates these structures with hardware components. It is well-known among those skilled in the art that "a network mobile device" is a term of art for various mobile communications device, all of which are implemented in hardware (see, *e.g.*, page 2, lines 19-22: "the present invention is described in terms of a *mobile phone system*; however, the present invention is much broader and may include any *multimedia or telecommunication device*"). Moreover, there is no question that, to one skilled in the art, "a transceiver" refers to physical hardware device. Further, to one skilled in the art, "memory" clearly refer to some form of memory hardware, for example, RAM. In addition, it is well-known in the art that the ordinary and customary means used to execute operations is a processor, which is ordinarily and customarily implemented in hardware.

Implementing the above components as purely software, as suggested by the Examiner, is most certainly an unordinary meaning of these terms. Upon hearing any of the terms referenced above, especially "a network mobile device," "a transceiver" and "memory" one skilled in the art would immediately think of hardware components, not software. Thus, the plain meaning of these terms is that they are implemented in hardware and the claims should be interpreted as such.

Furthermore, this plain meaning is not inconsistent with the specification. First, paragraph [0033] clearly states that "Preferably, these elements are implemented in hardware on

one or more appropriately programmed general-purpose devices, which may include a processor, memory and input/output interfaces.” Thus, the above-described ordinary and customary meaning of “a network mobile device,” “a transceiver” and “memory” is not inconsistent with the specification, which recites a hardware embodiment. Additionally, as described in the present specification, Fig. 2 clearly depicts hardware components (see, *e.g.*, page 2, line 27-page 3, line 6 and page 3, line 24-page 4, line 22). As such, these terms in the present claims should be given their plain meaning and interpreted as hardware components.

The Examiner contends that according to the specification, page 2, lines 18-25 of the present specification which states “the elements shown in the Figs. may be implemented in ... software,” the claimed components can be implemented in all software. While the specification does make this statement, it also states that “the elements in the Figs. may be implemented in various forms of hardware” and “Preferably, these elements are implemented in hardware.” The applicants respectfully point out that the claims of an application do not have to encompass all embodiments disclosed in the specification. As discussed above, when the words of claims 1 and 10 are given their plain meaning, it is clear that these claims are directed to embodiments which include hardware. Moreover, claim 1 is directed to a device which is certainly statutory subject matter.

Based on the foregoing, it is believed that claims 1 and 10 are directed to statutory subject matter. Further claims 2-9 and 11-19 are also believed to be directed to statutory subject by at least their dependence from claims 1 and 10. Reconsideration of the rejection is earnestly solicited.

**Rejections under 35 U.S.C. 102(b)**

By the Office Action, claims 1-6, 8-11 and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication No. 2002/0059434 to Karaoguz et al. (hereinafter Karaoguz). Applicants assert that at the very least, Karaoguz does not anticipate claims 1 and 10.

Karaoguz is directed to a multi-mode controller which uses techniques for controlling and managing network access to selectively communicate with available wireless networks. Karaoguz teaches a system which detects all available networks and connects to one of these available networks either through preprogrammed preferences or a manual user command.

Karaoguz does not, however, teach or suggest “associating networks with individual operations which can be performed on each network using the transceiver,” as recited in amended claim 1 and essentially recited in amended claim 10.

As is evident by the above-quoted portion of claim 1, the present invention solves a completely different technical problem than Karaoguz. The present invention is directed to minimizing expenses associated with cellular airtime usage by strategically using various network technologies to accomplish different communication tasks (see page 1, lines 11-17). A mobile device implementing the present invention includes intelligence to assign functions to specific networks in the most cost effective manner. Page 4, lines 23-32 explicitly describes this functionality:

If the user selects to perform a network-aware operation, the device will first check to see what type of network it is communicating with. Depending on the user settings, network aware operations will be performed from the user’s mobile device only if the appropriately associated network is available. If the operation is not urgent and the user

*is on a cellular network, the mobile device may not perform the operation immediately.* Instead, the device will detect when the user enters, for example, a WLAN hotspot region. *Once a WLAN is detected, the device will turn on its WLAN radio and connect with the WLAN network. At that point, it will perform the user's requested operation.* Because of cheaper WLAN airtime rate, cost savings result. (emphasis added)

Thus, through the correlation of operations to networks, the present invention provides a user with more flexible and cost effective communication without any substantial sacrifice in performance or transparency.

In contrast, Karaoguz makes no mention of assigning certain communications to certain networks. Instead, Karaoguz uses only one of the networks found to perform all functions (see, e.g., Fig. 3, paragraph [0041]: “multi-mode communication device will select one of two or more available networks,” and paragraph [0008]: “the device may switch from the network with which it was connected to the network with the high speed Internet access”). Without the intelligence to assign functions to specific networks in the most cost effective manner, Karaoguz cannot limit costly cellular airtime usage to network traffic types which necessitate it. Thus, it is clear that Karaoguz does not contemplate the present invention. As such, the present invention certainly demonstrates novelty and represents notable progress over Karaoguz.

Furthermore, Karaoguz does not disclose or suggest “memory which stores information associating networks with individual operations,” as recited in claim 1 and essentially recited in claim 10. While Karaoguz does disclose a data storage means, this data storage means does not store “information associating networks with individual operations.” As explained in paragraph [0048] of Karaoguz:

a data memory 84 may include information 96 that indicates, for example, that the device should: 1) never connect to a particular network; 2) always connect to a particular network if that network is detected; 3) prompt the user of the device for input as to whether the user wishes to connect to the network; and/or 4) connect to the network depending on other options.

Thus, Karaoguz merely teaches storing general preference data for each network, which instructs the device to which network it should connect when multiple networks are made available. Karaoguz does not remotely suggest that this data storage means stores assignments of certain operations to specific networks. Therefore, claims 1 and 10 which claim “memory which stores information associating networks with individual operations,” are clearly patentable over Karaoguz.

Therefore, applicants assert that claims 1 and 10 are distinct and patentable over Karaoguz for at least the reasons mentioned above. In addition claims 2-9 and 11-19 are believed to be patentable over the cited art at least by virtue of their dependency from claims 1 and 10. Reconsideration of the rejection is respectfully requested.

#### **Rejections under 35 U.S.C. 103(a)**


By the Office Action, claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaoguz. Since claims 7 and 12 are dependent from claims 1 and 10 respectively, applicants assert that these claims are patentable over Karaoguz for at least the reasons discussed above with reference to those independent claims. Reconsideration of the rejection is respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claim now pending in the application is in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's Deposit Account No. 07-0832.

Respectfully submitted,

Date: 4-28-09

  
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